The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte W. ROY KNOWLES

Appeal No. 2004-2301
Application No. 09/619,142

ON BRIEF

Before GARRIS, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2004) from the examiner's final rejection of claims 1 through 5, 7 through 16, and 18 through 22 (final Office mailed Feb. 20, 2003, paper 28), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to: (i) a "composition of matter intended for topical use in preventing or treating

alopecia, or maintaining healthy hair" (claims 1-5, 7, and 11); (ii) an article of manufacture (claims 8-10); and (iii) a "method for preventing or treating alopecia, or maintaining healthy hair" (claims 12-16 and 18-22). Further details of this appealed subject matter are recited in representative claims 1 through 4 and 11 reproduced below:

> 1. A composition of matter intended for topical use in preventing or treating alopecia, or maintaining healthy hair, said composition of matter comprising:
>
> a) an active compound selected from the group consisting of: a pharmaceutically or cosmetically effective topical amount of a 5α-reductase inhibitor and minoxidil, and
>
> b) a non-retinoid penetration enhancer, said penetration enhancer present in a concentration sufficient to aid said active compound in penetrating the skin surface to a depth of approximately the depth of hair bulbs.
>
> 2. The composition of claim 1, wherein said active compound comprises a 5α-reductase inhibitor.
>
> 3. The composition of claim 1, wherein said active compound comprises minoxidil.
>
> 4. The composition of claim 3, further comprising a 5α-reductase inhibitor.
>
> 11. The composition of claim 4, further comprising a sunscreen in an amount effective to screen radiation.

The examiner relies on the following prior art references as evidence of unpatentability:

Zupan	4,440,777	Apr. 03, 1984
Gibson	5,015,470	May 14, 1991
Bazzano	5,183,817	Feb. 02, 1993
Grollier et al. (Grollier)	5,192,534	Mar. 09, 1993
Schostarez	5,373,012	Dec. 13, 1994

In addition, the examiner refers (examiner's answer mailed Jul. 1, 2004, paper 37, page 15) to the following prior art references to establish a state of fact:[1]

Rajadhyaksha	5,482,965	Jan. 09, 1996

CAPLUS Abstract AN 1998:223670 of Stephen A. Mikulak, Thomas C. Vangsness, and Marcel E. Nimni, "Transdermal delivery and accumulation of indomethacin in subcutaneous tissues in rats," 50(2) J. PHARMACY & PHARMACOLOGY 153-58 (Apr. 22, 1998) (hereinafter "Mikulak").

The appealed claims stand rejected as follows:

I. claims 1 through 5, 7 through 16, and 18 through 22 under 35 U.S.C. § 112, ¶1, as failing to comply with the written description requirement (answer at 6);

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[1] "[E]xtrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference." In re Baxter Travenol Laboratories, 952 F.2d 388, 390, 21 USPQ 2d 1281, 1284 (Fed. Cir. 1991).

II. claims 1 through 4 and 12 through 15 under 35 U.S.C. § 102(b) as anticipated by Bazzano (id. at 7-8);

III. claims 1, 3, 12, and 14 under 35 U.S.C. § 102(b) as anticipated by Gibson (id. at 8-9);

IV. claims 1, 2, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Zupan (id. at 9);

V. claims 2, 4, 5, 7 through 10, 13, 15, 16, and 18 through 21 under 35 U.S.C. § 103(a) as unpatentable over Gibson in view of Bazzano or Schostarez (id. at 10-12); and

VI. claims 11 and 22 under 35 U.S.C. § 103(a) as unpatentable over Bazzano in view of Grollier (id. at 12-13).

We affirm each of the aforementioned rejections. Because we are in complete agreement with the examiner's factual findings and legal conclusions as to each issue, we adopt them as our own and add the following comments for emphasis.[2]

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[2] The appellant states: "The claims are each separately patentable as explained in detail in the following Argument [section of the appeal brief]." (Appeal brief filed Jul. 18, 2003, paper 33, p. 6.) We note, however, that the "ARGUMENT" section of the brief does not provide any argument in support of the separate patentability of any particular claim. Under these circumstances, we confine our discussion of each of the rejections to a single representative claim as follows: (I)

I. Lack of Written Description: Claims 1-5, 7-16, & 18-22

The examiner's position is as follows (answer at 6):

> All pending claims are rejected under 35 U.S.C. 112, first paragraph, because the newly introduced limitation(i.e. a non-retinoid penetration enhancer) recited in the claim 1 is considered to be a "new matter" wherein said limitation is not supported by the original disclosure or there is no pertinent teaching of retinoid penetration enhancer(s) or exclusion of retinoid penetration enahncer(s) [sic] in the original disclosure.

The appellant, on the other hand, argues (appeal brief at 8):

> Excluding subject matter not considered the applicant's invention is one of the main reasons to have patent claims - that's what patent claims are for! In so doing, claims can exclude subject matter by reciting negative limitations.

We cannot agree with the appellant.

To satisfy the written description requirement of 35 U.S.C. § 112, ¶1, the disclosure of the application as originally filed must reasonably convey to those skilled in the relevant art that the applicant, as of the filing date of the original application, had possession of the claimed invention. In re Alton, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1581 (Fed. Cir.

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claim 1; (II) claim 1; (III) claim 1; (IV) claim 1; (V) claim 2; and (VI) claim 11. 37 CFR § 1.192(c)(7)(2003)(effective Apr.

1996); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In an amendment filed Jan. 10, 2002 (paper 20), the appellant amended claim 1 to recite that the composition comprises, inter alia, a "non-retinoid penetration enhancer." This amendment was made to overcome the examiner's rejection over Bazzano. (Amendment at 3.)

The originally filed disclosure, however, does not reasonably convey to one skilled in the relevant art that the appellant had possession of a composition comprising the recited active compound and the recited non-retinoid penetration enhancer. To the contrary, the originally filed disclosure is all-encompassing in terms of the types of penetration enhancers (except for liposomes) that may be used. (Specification, page 9, line 14 to page 11, line 2.) Absent some blazemark indicating to one skilled in the relevant art that the appellant had possession of a composition comprising the recited active compound and a sub-genus of penetration enhancers defined as non-retinoid penetration enhancers, amended claim 1 violates the written description requirement of 35 U.S.C. § 112, ¶1.

21, 1995).

Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996)("In the absence of...blazemarks, simply describing a large genus of compounds is not sufficient to satisfy the written description requirement as to particular species or sub-genuses."). In this regard, it is important to emphasize that in assessing the sufficiency of the original disclosure, a "description which renders obvious the invention...is not sufficient." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Nor is conclusive evidence of a claim's enablement necessarily conclusive of a claim's compliance with the written description requirement. In re Curtis, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004). Furthermore, in a situation much like the one before us, the applicants in Ex parte Grasselli, 231 USPQ 393, 394 (Bd. Pat. App. & Int. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984), introduced new concepts not supported by the original disclosure when the claim was amended to exclude the presence of halogen, uranium, or co-presence of vanadium and phosphorus in a catalytic process of ammoxidation of propane or isobutane to obtain acrylonitrile or methacrylonitrile.

The appellant argues (appeal brief at 7): "Having already accepted Paper No. 20, the Examiner is respectfully believed estopped from now conjuring up alleged new grounds to object [sic, reject]." This argument lacks merit. The appellant does not point to, and we are unaware of, any legal authority that binds an examiner to repeat an error made in a previous Office action. "The PTO's responsibility for issuing sound and reliable patents is critical to the nation." BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1274, 63 USPQ2d 1534, 1538 (Fed. Cir. 2002). In this case, the examiner appropriately fulfilled the PTO's responsibility by rejecting the claims on this ground.

The appellant further contends (appeal brief at 7):

> Applicant assumes the "new matter" is the amendment changing the claim nomenclature to "a non-retinoid penetration enhancer." This amendment adds a negative limitation to the claims. Negative limitations are specifically permitted where the Examiner fails to propose more clear verbiage. M.P.E.P. § 707.07(g)(2001) says, "Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the Examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition" (emphasis added). Here, the Examiner does not propose any "improved mode of definition." The objection should thus be withdrawn.

This contention is also without merit. As acknowledged by the appellant (appeal brief at 8), the examiner has not made a

"technical" rejection based on indefiniteness. Rather, the examiner has appropriately entered a substantive rejection under 35 U.S.C. § 112, ¶1, lack of written description.

The appellant urges (appeal brief at 8): "Excluding subject matter not considered the applicant's invention is one of the main reasons to have patent claims - that's what patent claims are for!" (Appeal brief at 8.) As authority for the introduction of negative limitations into a claim after an application is filed, the appellant relies on In re Barr, 444 F.2d 588, 595-97, 170 USPQ 330, 337-38 (CCPA 1971), as well as In re Wakefield, 422 F.2d 897, 903-04, 164 USPQ 636, 641-42 (CCPA 1970). (Id.)

We do not accept the notion that the cited cases authorize the introduction of new subject matter by way of a negative limitation into a disclosure after an application is filed. The issue before the court in In re Barr was lack of enablement, not lack of written description. In re Barr, 444 F.2d at 596-97, 170 USPQ at 338 ("Appellants have specifically disclosed how to make and use a large number of compounds and have asserted that other compounds, similar to the compounds disclosed in certain stated respects, may be made and used in the same fashion.").

In In re Wakefield, the court expressly stated that it would not consider the rejection as if it were made under 35 U.S.C. § 112, ¶1, because the appellants would be deprived of an opportunity to contest this new rejection. In re Wakefield, 422 F.2d at 904, 164 USPQ at 641. Thus, the appellant has failed to establish that these precedents are controlling on the facts of the present case.

The appellant argues that the specification should preferably omit material already known in the art and that, therefore, the original disclosure "need not teach retinoid penetration enhancer." (Reply brief filed Sep. 2, 2004, paper 39, page 3.) While the appellant is correct that (for purposes of enablement) a specification does not have to include what is already known in the art, this cannot be used as a license to introduce new subject matter not in possession of the applicant at the time of filing of the application. As we discussed above, the original disclosure lacks the requisite blazemarks that would reasonably convey to one skilled in the relevant art that the appellant had possession of the now claimed invention.

For these reasons, we uphold the examiner's rejection on this ground.

II. 35 U.S.C. § 102(b): Claims 1-4 & 12-15 over Bazzano

Bazzano states (column 1, lines 22-29):

> This invention relates to the use of synergistic combinations with minoxidil (2,4-diamino-6-piperidino-pyrimidine-3-oxide) or certain of its derivatives or analogs in order to increase the rate of and stimulate growth of hair on mammalian skins, particularly human scalp hair to prolong the anagen phase of the hair cycle, to convert vellus hair to growth as terminal hair, and to treat certain types of alopecias.

Bazzano further teaches that retinoids or mixtures thereof in combination with minoxidil and/or minoxidil-type compounds are particularly effective as synergistic combinations. (Column 3, lines 59-68.) As pointed out by the examiner (answer at 7), the retinoid compounds "cause excellent percutaneous absorption of themselves and other compounds used in combination therewith, and are very active on the keratinizing cells of the skin, including the hair follicles."[3] (Column 19, lines 38-42.) In the examples, Bazzano describes a topical lotion formulation containing 0.01 to 0.1% by weight of all-trans retinoic acid or

[3] While appealed claim 1 recites "a non-retinoid penetration enhancer," its language does not exclude the presence of a retinoid enhancer. In this regard, the term "comprising" (appealed claim 1, line 2) not only alerts potential infringers that the recited components "a)" and "b)" are essential, but that other unrecited components may be included and still form a construct within the scope of the claim. Cf. In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

13-cis retinoic acid, 0.5 to 5.0% by weight of minoxidil, q.s. to 100.0% by weight of ethanol, 5.0 to 50.0% by weight of propylene glycol, 0.1% by weight of butylated hydroxytoluene (BHT), and up to 10.0% by weight of distilled water. (Column 24, lines 20-30.)

To establish that the formulations exemplified in Bazzano inherently or necessarily contain a non-retinoid penetration enhancer, the examiner relies on extrinsic evidence. For example, Rajadhyaksha teaches that ethanol is a penetration enhancer for enhancing systematic administration of therapeutic agents transdermally. (Column 3, lines 28-36.) Similarly, Zupan teaches that propylene glycol is a penetration enhancer. (Column 4, lines 35-38.) Furthermore, Mikulak teaches that a 50:50 (volume/volume) mixture of propylene glycol and ethanol is a commonly used penetration enhancer. (Abstract.) Thus, propylene glycol and ethanol are in fact penetration enhancers, even though they are also disclosed in Bazzano as suitable vehicles. Because propylene glycol and ethanol have penetration enhancing properties, it would reasonably appear that, in Bazzano, these compounds (in concert with the retinoid compound) inherently or necessarily aid the minoxidil in penetrating the skin surface to a depth of approximately the depth of hair

bulbs. On this point, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicant to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

From these findings, we agree with the examiner that Bazzano describes each and every limitation of the invention recited in appealed claim 1. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Again, the appellant contends that the examiner is "estopped from contradicting...earlier factual findings." (Appeal brief at 11.) In support of this contention, the appellant relies on Overland Motor Co. v. Packard Motor Co., 274 U.S. 417, 421 (1927), and Allen v. McCurry, 449 U.S. 90, 94 (1980).

The appellant's reliance on these precedents is in error. The issue in Overland was whether the applicant, in canceling a finally rejected claim, abandoned the canceled claim or estopped himself from thereafter seeking it through a new application.

Overland, 274 U.S. at 420. The Court's answer was no. Id. at 421. Thus, this case has nothing to do with the facts of the present case.

Likewise, Allen concerns whether: (1) the rules of collateral estoppel applied to actions brought under the Civil Rights Act of 1871 and encompass state court judgments or decisions, be they civil or criminal; and (2) the unavailability of federal habeaus corpus relief on a Fourth Amendment claim renders the doctrine of collateral estoppel inapplicable. Allen, 449 U.S. at 90.

The appellant argues that Bazzano "says long-term use of retinoic acid will 'probably cause the hair to fall out,'" whereas "the claimed combination...has been shown to be unexpectedly effective, even in long-term use." (Reply brief at 5.) This argument is unpersuasive. Bazzano teaches effective amounts of the active ingredient to avoid the toxicity caused by overdosage. (Column 20, line 54 to column 21, line 2.) Moreover, appealed claim 1 does not exclude retinoic acid, even in major amounts relative to other components. As to unexpected results, such evidence cannot constitute a factual basis to overcome a rejection based on a reference that fully describes

the claimed invention. In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974).

For these reasons, we uphold the examiner's rejection on this ground.

III. 35 U.S.C. § 102(b): Claims 1, 3, 12, & 14 over Gibson

Gibson teaches cosmetic and pharmaceutical compositions for topical application to mammalian skin or hair, containing an enzyme inhibitor capable of promoting hair growth, especially hair growth on the human scalp. (Column 1, lines 6-10.) In particular, Gibson teaches a composition containing minoxidil and a penetration enhancer, none of which are retinoids. (Column 4, line 40 to column 5, line 57.) According to Gibson, "the presence of a penetration enhancer can potentiate the benefit of the chemical inhibitor, by improving its delivery through the stratum corneum to its site of action in the immediate environment of the hair follicle close to the dermal papilla." (Column 14, lines 3-7.) As acknowledged by the appellant (appeal brief at 12-13), Gibson describes an effective hair growth composition containing 2% by weight of minoxidil in a vehicle of 70% ethanol, 20% water, and 10% propylene glycol. (Column 20, lines 12-25.) As we discussed above, the examiner

has adequately established that ethanol and propylene glycol have penetration enhancing properties.

From these factual findings, we determine that Gibson teaches each and every limitation of the invention recited in appealed claim 1.

The appellant appears to be arguing that there is no evidence to indicate that the ethanol and propylene glycol are present in a concentration sufficient to aid minoxidil to penetrate to a depth of approximately the depth of hair bulbs. (Appeal brief at 13, n.6.) We note, however, that the composition described in Gibson's Table 1 resulted in "a significant increase of 55% in hair growth." Thus, it would reasonably appear that the ethanol and propylene glycol are present in a concentration sufficient to aid minoxidil to penetrate to a depth of approximately the depth of hair bulbs. In re Best, 562 F.2d at 1255, 195 USPQ at 433-34.

The appellant alleges that Gibson fails to enable the claimed invention. (Appeal brief at 14.) Specifically, the appellant states that Gibson "lists several thousand examples of what he calls 'penetration enhancers.'" (Id.) We are not persuaded. The appellant's recited "non-retinoid penetration

enhancer" is just as broad, if not broader than those listed at Gibson's column 4, line 41 to column 5, line 51.

The appellant contends that Gibson "fails to expressly say which 'penetration enhancer' should be combined with minoxidil, nor how much of the penetration enhancer should be used, nor how much minoxidil should be used, to create a composition to penetrate to a depth of the hair bulbs." We disagree. Gibson clearly discloses which penetration enhancers should be used. (Column 4, line 40 to column 5, line 51.) Regarding the suitable amounts for the minoxidil and penetration enhancer, the appellant has not carried the burden of establishing that one skilled in the art would be subject to any undue experimentation. In this regard, the presumption of validity of a United States patent under 35 U.S.C. § 282 (2004) applies even in the context of patent prosecution. Cf. In re Spence, 261 F.2d 244, 246, 120 USPQ 82, 83 (CCPA 1958).

The appellant further alleges that Gibson's disclosure "includes many compounds not generally recognized in pharmacology as safe." (Appeal brief at 14.) Even assuming that the appellant's allegation is correct, we find nothing in the language of appealed claim 1 that reflects the requirement that the penetration enhancer must be pharmacologically safe.

While appealed claim 1 does recite "for topical use," Gibson's composition is designed for topical use as well. (Column 4, line 22-24.)

For these reasons, we uphold this ground of rejection.

IV. 35 U.S.C. § 102(b): Claims 1, 2, 12, & 13 over Zupan

The appellant does not dispute the examiner's factual finding (answer at 9) that "Zupan teaches a progesterone in combination with eucalyptol(or other penetration enhancers) for treating alopecia..." Nor does the appellant contest the examiner's finding that Zupan's progesterone is a 5α-reductase inhibitor. Rather, the appellant's main argument is that Zupan "teaches drug delivery completely through the skin and into the systemic circulation," not "to a depth of approximately the depth of hair bulbs." (Appeal brief at 22.)

The appellant's position is not well taken. Complete penetration through the skin and into the systemic circulation necessarily involves penetration "to a depth of approximately the depth of hair bulbs." That is, appealed claim 1 does not exclude penetration beyond the depth of hair bulbs.

Without any explanation, the appellant refers to the applicant's 37 CFR § 1.132 declaration filed on Feb. 12, 2001.

(Reply brief at 15.) There, the applicant avers that known systemic side effects of minoxidil or progesterone would have dissuaded one of ordinary skill in the art to combine these active agents with a penetration enhancer. (Declaration at 3.) We disagree. Zupan expressly teaches the combination of progesterone with a penetration enhancer.

Accordingly, we also uphold this ground of rejection.

V. 35 U.S.C. § 103(a): Claims 2, 4, 5, 7-10, 13, 15, 16, & 18-21 over Gibson in View of Bazzano or Schostarez

Appealed claim 2 recites that the "active compound comprises a 5α-reducatse inhibitor."[4]

Bazzano teaches that progesterones may be added to the composition as an adjunctive compound. (Column 20, lines 5-20.) Accordingly, one of ordinary skill in the art would have found it prima facie obvious to add progesterone into the formulation described in Bazzano's column 24, lines 20-30 as expressly taught by the reference, thus arriving at a composition encompassed by appealed claim 2.

[4] In the event of further prosecution, the term "comprises" should be corrected to "is," because the independent claim (i.e., claim 1) recites a closed Markush group for the "active compound." Thus, it is inappropriate to use the open language

Schostarez teaches that 5-fluoro-substituted minoxidil has superior transdermal transport properties over unsubstituted minoxidil, thus permitting the topical application of less amounts of active agent to achieve the same hair growth while minimizing side effects. (Column 1, lines 40-49.) Schostarez further teaches the use of 5α-reducatse inhibitors in combination with the 5-fluoro-substituted minoxidil for the treatment of various conditions including alopecia. (Column 3, lines 49-57; column 4, lines 57-66.) Schostarez also teaches the use of vehicles such as propylene glycol and ethanol, both of which inherently have penetration enhancing properties, and expressly discloses that the use of penetration enhancers such as oleyl alcohol in concentrations of about 1% by weight may be beneficial. (Column 4, lines 37-50.)

Given these teachings in Schostarez, we share the examiner's view (answer at 10) that one of ordinary skill in the art would have been led, prima facie, to combine Gibson with Schostarez in order to obtain the advantages described in Schostarez at column 1, lines 36-49, thus arriving at a composition encompassed by appealed claim 2. Thus, both the

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"comprising." The same problem exists in appealed claims 3 and 4.

motivation to combine the references and the requisite reasonable expectation of success are founded in the prior art, not the appellant's own disclosure. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)(citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

The appellant argues that Schostarez "teaches away from combining 5-fluoro minoxidil with skin penetrant" because this active agent penetrates completely through the skin without the need for a penetration enhancer. (Appeal brief at 20.) According to the appellant, this would be undesirable because the active agent has known side effects. (Id.) We cannot agree. In combination with a penetration enhancer, even less active agent would be required, thus further minimizing the known side effects. (Column 1, lines 40-49.)

As to appealed claim 7, which the examiner discussed separately, we are in full agreement with the examiner's analysis. (Answer at 11.) In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003)("The normal desire of scientists or artisans to improve upon what is generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.");

In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980)("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.").

For these reasons, we uphold this ground of rejection.

VI. 35 U.S.C. § 103(a): Claims 11 & 22 over Bazzano & Grollier

Appealed claim 11 further recites a sunscreen.

Bazzano does not disclose the use of a sunscreen as part of the composition. However, Bazzano teaches (column 23, lines 8-11): "The subjects were advised to wear a cap for protection from the sun or to refrain from excessive sun exposure, and to avoid trauma to the scalp..."

Grollier teaches the use of agents for screening out UV radiation in compositions for inducing hair growth and/or retarding its loss. (Column 1, lines 9-12; column 2, lines 3-18.)

Thus, one of ordinary skill in the art would have found it prima facie obvious to combine Grollier with Bazzano by adding

Grollier's agent for screening UV radiation into Bazzano's composition, with the reasonable expectation of obtaining the advantages of UV screening. In re Vaeck, 947 F.2d at 493, 20 USPQ2d at 1442.

Because the appellant does not rebut this rejection with any persuasive argument, we uphold this ground of rejection as well.

Summary

In sum, we affirm the examiner's rejections under: (i) 35 U.S.C. § 112, ¶1, of appealed claims 1 through 5, 7 through 16, and 18 through 22 as failing to comply with the written description requirement; (ii) 35 U.S.C. § 102(b) of appealed claims 1 through 4 and 12 through 15 as anticipated by Bazzano; (iii) 35 U.S.C. § 102(b) of appealed claims 1, 3, 12, and 14 as anticipated by Gibson; (iv) 35 U.S.C. § 102(b) of appealed claims 1, 2, 12, and 13 as anticipated by Zupan; (v) 35 U.S.C. § 103(a) of appealed claims 2, 4, 5, 7 through 10, 13, 15, 16, and 18 through 21 as unpatentable over Gibson in view of Bazzano or Schostarez; and (vi) 35 U.S.C. § 103(a) of appealed claims 11 and 22 as unpatentable over Bazzano in view of Grollier.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris)
Administrative Patent Judge)
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) BOARD OF PATENT
Charles F. Warren)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
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Appeal No. 2004-2301
Application No. 09/619,142

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